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JUL 08 2005

In re Application of:
Won-Suk YANG et al.
Serial No.: 09/313,659
Filed: May 18, 1999
Attorney Docket No.: SEC.636

DECISION ON PETITION
TO WITHDRAW HOLDING OF
ABANDONMENT

This is a decision on the petition filed July 11, 2001, to withdraw the unauthorized examiner's amendment and reopen prosecution, the petition filed April 17, 2004 to withdraw the improper holding of abandonment under 37 C.F.R. § 1.181 and the petition filed August 9, 2004, to invoke supervisory authority under 37 C.F.R. § 1.181, and to withdraw the holding of abandonment. All of the petitions will be treated herein.

The petitions are **GRANTED**.

The application was held abandoned for failure to timely pay the issue fee in response to the Notice of Allowance and Issue Fee Due (Notice of Allowance) mailed on April 11, 2001, setting a three-month statutory period to pay the issue fee. The issue fee was not paid, but a petition to withdraw an unauthorized examiner's amendment and reopen prosecution was filed instead on July 11, 2001, the due date of the issue fee. A Notice of Abandonment was subsequently mailed on October 10, 2001.

BACKGROUND

Petitioner asserts that the examiner of record issued an improper Final Rejection on January 25, 2001 by applying a new rejection to claim 15, which had not been amended in a previous response. During conversations with the examiner on March 1, 2001 and March 7, 2001, petitioner claims to have discussed the finality of the office action with the examiner and that the examiner did not wish to withdraw the finality of the office action unless a written request was filed. It was, however, agreed to that claims 1 - 19 were patentable over the cited prior art but

claims 9 and 19 still had a pending 35 U.S.C. § 112, first paragraph, new matter rejection. The examiner proposed deleting any reference to BF₂ in the claims to place the application in condition for allowance. Petitioner states that he told the examiner that he would pass this request on to the Applicants for review but did not agree to the proposed amendments.

Petitioner then received a Notice of Allowance, mailed April 11, 2001, with an Examiner's Amendment deleting the references to BF₂ in claims 9 and 19 and reinserting a reference to BF₃ in claim 18. Although claim 18 had not been rejected under 35 U.S.C. § 112, first paragraph, and contained no reference to BF₂, it appears (although unclear) from the examiner's amendment that the reference to BF₃ was reinserted. Petitioner filed a Letter on April 19, 2001 describing the content of the conversations on March 1, 2001 and March 7, 2001 and asserting that the Examiner's Amendment was unauthorized.

Petitioner next filed a petition on July 11, 2001, the date the issue fee was due, to (a) withdraw the unauthorized Examiner's Amendment, and (b) reopen prosecution so as to properly resolve the issues surrounding the 35 U.S.C. § 112, first paragraph, rejection of claims 9 and 19. Petitioner also requested that the Notice of Allowance of April 11, 2001 be withdrawn. In the alternative, petitioner authorized the charge of the issue fee if necessary to maintain the pendency of the application and provided the deposit account number. This petition is date stamped July 11, 2001.

A review of the file record indicates that this petition was placed in the file but was not entered or considered. However, the examiner wrote in the left hand margin of the petition to see the Supplemental Notice of Allowance of August 2, 2001, subsequently mailed on August 3, 2001. With this Supplemental Notice of Allowance the examiner provided a Supplemental Examiner's Amendment replacing all references to BF₃ with BF₂ stating that "[a]lthough the above changes do not find literal support in the specification, the applicant's error corrected here is one that is self-evident and therefore is not new matter, BF₃ is a neutral compound whereas "BF₂" is an ion that is commonly used for implantation of boron into semiconductor substrate". Petitioner was apparently not consulted with respect to this amendment.

Petitioner received the Notice of Abandonment on October 10, 2001 for failure to timely pay the issue fee in response to the Notice of Allowance mailed on April 11, 2001.

Petitioner then filed a petition to withdraw improper holding of abandonment on April 17, 2002 noting that petitioner had not received a formal decision on the petition filed July 11, 2001. Petitioner also noted that the improper Examiner's Amendment was not withdrawn until after the issue fee was due and the examiner did not extend the courtesy of also withdrawing and then re-dating the Notice of Allowance. Petitioner provided a postcard receipt showing proper receipt of the petition filed July 11, 2001 and a postcard receipt showing receipt of a PTOL-85B Issue Fee Transmittal on August 21, 2001. A review of the file record does not reveal the Submission of Form PTOL-85B. This petition has been entered in the file but not considered.

Petitioner then filed the petition of August 9, 2004 to withdraw the improper holding of abandonment under 37 C.F.R. § 1.181. This petition includes the petition filed on April 17,

2002, the Submission of Form PTOL-85 on August 21, 2001, the petition filed on July 11, 2001, and the Letter filed on April 19, 2001, all properly date stamped.

OPINION

Improper Final Rejection

- MPEP 706.07(a) - examiner may not make final if new ground of rejection
- MPEP 706.07(c) - premature final rejection - Any question as to prematurity of a final rejection **should** be raised, if at all, while the application is **still pending before the primary examiner**. This is purely a question of practice, wholly distinct from the tenability of the rejection.
- MPEP 706.07(d) - If, on **request by applicant** for reconsideration, the primary examiner finds the final rejection to have been premature, he or she **should withdraw the finality** of the rejection. The finality of the Office action **must** be withdrawn while the application is still pending. The examiner cannot vacate the final rejection once the application is abandoned. Form paragraph 7.42 should be used when withdrawing the finality of the rejection of the last Office action.

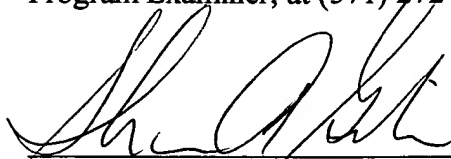
Unauthorized Examiner's Amendment

- MPEP 1302.04 - must be **authorized**
- MPEP 1302.14 -
 - It should also specify that comments may be filed by the applicant on the statement and **should preferably** be submitted with the payment of the issue fee so as not to delay processing of the application and in **any event no later than payment** of the issue fee.
 - Comments filed by the applicant on the examiner's statement of reasons for allowance, **should preferably be submitted no later than the payment** of the issue fee, to avoid processing delays. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

A review of the application file wrappers reveals that the application was not clearly in condition for allowance, in that all issues had been resolved, at the time of mailing the first Notice of Allowability on April 11, 2001. As such, the mailing of the Notice of Allowance was premature. Accordingly, the abandonment of the application was premature.

For the above stated reason, the petitions are granted. The Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn. The application is restored to pending status. In order to clarify the record, the Examiner's Amendments, and the comments made therein, on April 11, 2001, and on August 03, 2001, are hereby vacated. The Notice of Allowance and Issue Fee Due mailed on April 11, 2001 is hereby vacated and the indicated allowance of the claims is hereby withdrawn. The application will be returned to the examiner for further prosecution.

Any inquiry concerning this petition should be directed to Clayton E. LaBalle at, Special Program Examiner, at (571) 272-1594.

A handwritten signature in black ink, appearing to read 'Sharon Gibson', written over a horizontal line.

Sharon Gibson, Director
Technology Center 2800